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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,378	01/05/2001	Craig W. Barnett	55534.00045	4429

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EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No. 09/754,378	Applicant(s) BARNETT ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 47-75 have been examined.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 47, 55, 63, 65, 66, 71, 72, 75 rejected under 35 U.S.C. 101 as claiming the same invention as that of claim independent claim 1 in combination with dependent claim 4 of prior U.S. Patent No. 6,321,108. This is a double patenting rejection. The Claims stated above in the Application do not present any features distinct from the features already stated in independent Claim 1, and it's dependent claims, of Patent 6,321,208.

4. Claims 47, 55, 63, 65, 66, 71, 72, 75 of this application conflict with claim 47, 55, 63, 71, 73, 74, 79, 80, 83, 84, 85, 88, 89 of Application No. 09/543,735. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear

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line of demarcation between the applications. See MPEP § 822. Patent Application 09/754,378 and Patent Application 09/543,735 present no novel features over the Independent and Dependent claims in each.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 64, 73 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 64 discloses the feature: “(ii) a disablement field indicative of a date when the coupon will be rendered unprintable at the remote terminal”.

The Applicant’s disclosure supports deleting a coupon which has a date past a fixed date (page 27, lines 10-15). However, the Applicant’s specification does not support making a coupon unprintable when that coupon’s expiration date is passed a certain date.

Claim 73 discloses the feature ”wherein the information transmitted comprises only demographic information about a user.”

The Applicant’s specification does support transmitting demographic information about a user. However, the Applicant’s specification does not support transmitting ONLY demographic

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information about a user. In fact, the word 'only' never appears in the specification in relation to demographic information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 47-51, 53-59, 61-63, 65-72, 74, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (6,292,786).

Claims 47, 55, 63, 65, 66, 71, 72, and 75:

Deaton discloses an online method for viewing and printing at a remote terminal user-specific coupons based on a user profile, the method comprising:

storing in a storage device at a central location electronic coupon information pertaining to a group of coupons available; (col 5, lines 43-55; col 18, lines 37-40; col 18, lines 42-47),

receiving at a central location a request from a user of a remote terminal, the request being received over a network and being a request for access to stored coupon information (col 6, lines 4-6; col 6, lines 25-50);

determining at the central location if the user is a registered user, (col 4, lines 15-36; col 6, lines 25-50) and if the user is not registered, taking a specific procedure (col 6, lines 38-49):

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receiving and storing a user profile at the central location; (col 10, lines 25-42; col 6, lines 25-50) and

downloading to the remote terminal a coupon data management software module for managing the printing of coupons, including unique user identification information (col 18, lines 42-47);

if the user is registered, accessing the stored user profile (col 10, lines 25-42; col 6, lines 25-50);

the user viewing, a subset of coupons from the group of coupons, the subset of coupons being based on user-specific information, which comprises user profile information and/or user usage history information (col 18, lines 5-35; col 9, lines 30-50; col 10, lines 25-42);

the user selecting at least one coupon from the subset of coupons for printing, the coupon comprising various fields, including: a redemption amount field and at least one other field, the redemption amount field comprising data indicative of a discount provided by the coupon, the redemption amount field and at least one other field being variable in accordance with user-specific information associated with the requesting user; (col 18, lines 25-47); and

transmitting the selected coupon to a remote terminal in response to a received user request (col 18, lines 42-47) and,

a user print the coupon at the remote terminal. (col 18, lines 42-47)

receiving at the remote terminal the selected coupon, subsequently varying at least one of the various fields of the selected coupon, transmitting the revised field, and replacing at the remote terminal the previously received field with the revised field, and printing a revised coupon (col 9, lines 35-50; col 10, lines 5-25);

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generating a shopping list of products associated with the selected coupons, where the list can be printed (col 18, lines 30-35).

Deaton discloses identifying whether a customer is a member (col 6, lines 25-50) and that different procedure are performed depending on whether a customer is a member or not (col 6, lines 37-49). Deaton also discloses tracking customer demographic, profile, and identification information and allowing the customer to enter such data (col 8, lines 32-45).

Deaton does not explicitly disclose that customers can be offered membership if they are not already registered.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Deaton can offer unidentified customers membership. Deaton would have been motivated to do this so that customers can become members and have full access to the offerings of the incentives and also so that the customers can be better tracked for marketing (col 4, lines 33-36) purposes.

Claim 48: Deaton discloses a method as in claim 47, and further discloses that he central location receives from the remote terminal data indicative of coupons printed by the user (col 18, lines 45-50).

Claim 49, 67: Deaton discloses the method of claim 47, 66, and Deaton further discloses the step of sorting coupons by a predetermined classification (col 19, lines 8-13; col 5, lines 50-55).

Claim 50, 58, 68: Deaton discloses the method of claims 47, 55, 66.

Deaton further discloses a unique coupon, limiting a coupon to only be able to be redeemed once, and being able to print a coupon (col 18, lines 42-55). Deaton does not

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explicitly disclose that the coupon can be limited to be printed only once. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Deaton can limit the user to redeeming the coupon only once by limiting the user to printing the coupon only once. One would have been motivated to do this because limiting the printing of coupons is an effective way to prevent them from being fraudulently redeemed.

Claim 51, 59, 69, 70: Deaton discloses the method of claim 47, 55, 68, 69, and Deaton further discloses that each printed coupon is unique and comprises a bar code encoded with identification information (col 18, lines 46-52).

Claim 53, 57, 61: Deaton discloses the method of claim 47, 56, 55, and Deaton further discloses the step of collecting user-specific data for subsequent processing and analysis (col 4, lines 15-35; col 10, lines 25-42).

Claim 54, 62: Deaton discloses the method of claim 47, 55, and Deaton further discloses the step of receiving and storing at the remote terminal fixed coupon data, wherein the coupon includes variable coupon data and fixed coupon data, the fixed coupon data file comprising fixed coupon parameters and user-specific data (col 18, lines 14-35; col 17, lines 37-45).

Claim 56: Deaton discloses the method of claim 55, and Deaton further discloses the step of reading at a redemption site the presented coupon to retrieve information from the coupon and storing retrieved information (col 4, lines 15-25).

Claim 74: Deaton discloses the method of claim 72, and further discloses receiving electronic coupon information is received at a plurality of servers from the least one coupon source (Fig. 1).

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7. Claims 52, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (6,292,786) in view of DeLapa (6,076,068).

Claim 52, 60: Deaton discloses the method of claim 47, 55. Deaton further discloses searching coupons by dates (col 13, lines 30-35). Deaton further discloses that the coupon has user-specific information and specific coupon information (col 18, lines 10-35). Deaton further discloses customizing incentive offers at point of sale to further induce a customer to make a purchase (col 9, lines 30-50). Deaton does not explicitly disclose that the coupon comprises an expiration date field indicative of a coupon expiration date, the expiration date field being variable based on user-specific information.

However, DeLapa discloses tracking the expiration date of a coupon (col 2, lines 10-15) and that the actions related to the user and the coupon can be based on the expiration date (col 3, lines 55-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add De Lapa's utilization of expiration dates on coupons to Deaton's electronic coupon issuing. One would have been motivated to do this because Deaton already discloses modifying coupons to make them more attractive to users and modifying a coupon expiration date is an obvious way of making a coupon more attractive.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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8. Claims 47-75 could also be rejected under 35 U.S.C. 102(b) as anticipated by Von Kohorn (US 5,227,874 A) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Von Kohorn (US 5,227,874 A) in view of Von Kohorn (US 5,128,752 A).

Regarding claims 47-75, Von Kohorn '874 discloses the issuing and processing of electronic certificates or coupons (column 8, lines 44-48), which may be redeemed by mail or in retail establishments for cash, prizes, or discounts. The coupons are issued and processed in electronic form (column 2, lines 56 – 59). The coupons have transaction data (column 2, line 65 – column 3, line 2). The coupons have identification data allowing them to be traced to the household that requested them (column 2, lines 20 – 22). The '874 patent describes an electrical communication between a service system and an issuer system (column 19, lines 33 – 38) and contemplates the use of modems (column 44, lines 28 – 33). The '874 patent describes an electrical communication via a modem between the systems corresponding to the service system and the remote user stations (column 44, lines 28 – 22). The '874 patent discloses several methods for transmitting instructions from the issuer systems to the service system (column 83, lines 42 – 50; and column 77, line 62 – column 78, line 3). The '874 patent discloses obtaining remote user profile data (column 2, lines 8 – 12; and column 3, lines 3 – 7). The user profile data disclosed in the '874 patent is sufficient to specifically identify the remote user (column 2, lines 20 – 25). The '874 patent expressly discloses the use of response data (column 9, lines 33 – 38) to develop a processed response (correlation data). The '874 patent makes the correlation data available to the issuer systems (column 2, lines 13 – 17). The '874 patent discloses the selective transmission of coupons based upon data provided by the remote user (column 8, lines 44 – 48; and column 105, lines 1 – 5).

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The '874 patent discloses the selective transmission of coupons based upon data provided by the remote user (column 8, lines 44 – 48; and column 105, lines 1-5).

If for some reason it is thought that Von Kohorn's '874 patent does not specifically disclose that it is the service system that develops correlation data which categorizes the remote user profile data, then Von Kohorn's '752 patent discloses a cumulative record being kept by the generating unit 14 of all coupons requested by a member. It should be noted that the use of the profile data to develop correlation data is discussed by both the '874 and '752 Von Kohorn patents. However, the '752 patent provides additional details of Von Kohorn's disclosure. For instance, the '752 patent discloses that the cumulative record is compiled and retained in the generating unit 14 in memory 40 and can be made available to sponsors of promotions in different ways (column 6, line 66 – column 7, line 3). The '752 patent further discloses that the cumulative record of all coupons requested by and dispensed to a shopper can also be used to create a demographic database (column 9, lines 54 – 57).

In view of Von Kohorn '752, it would have been obvious to one of ordinary skill in the art at the time that the invention was made, to compile and retain the correlation data in the generating unit and memory of Von Kohorn's '874 service system, so that the cumulative record of all coupons requested by and dispensed to a shopper could also be used to create a demographic database for use in more focused marketing.

- b. Nichtberger (4,882,675) discloses a paperless coupon distributing system.
- c. Gregory (5,909,673) discloses site specific coupons.
- d. Larson (5,708,782) discloses dispensing electronic coupons.

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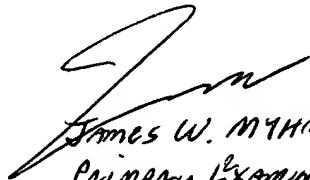
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



February 24, 2003



JAMES W. MYHRE
PRIMARY EXAMINER
ART UNIT 3622